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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------|
| 10/773,537   | 02/05/2004  | Danial S. Jones      | 8512-067                   | 6792             |
| 20575  | 7590        | 06/21/2005           |                            |                  |
| MARGER JOHNSON & MCCOLLOM, P.C.<br>1030 SW MORRISON STREET<br>PORTLAND, OR 97205 |             |                      |                            |                  |
|  |             |                      | EXAMINER<br>CHAMBERS, TROY |                  |
|  |             |                      | ART UNIT<br>3641           | PAPER NUMBER     |

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,537

Applicant(s)

JONES, DANIAL S.

Examiner

Troy Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, claims 1-9 in the reply filed on 06/10/05 is acknowledged.
2. Claims 10-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06/10/05.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5613483 issued to Lukas.
5. With respect to claim 1, Lukas discloses a cylinder 112, 47; a piston 124, 128 in said cylinders; a bolt 32 coupled to said pistons and comprising ports 44, 142; a sealing members comprising O-rings 125, 140, 50, 52, 58 etc.
6. With respect to claims 4 and 5, Lukas discloses compressed gas storage areas 110, 147, 148, 60 etc.
7. With respect to claim 6, Lukas discloses bolt ports 44, 142.
8. With respect to claim 7, the length of port 142 is greater than the width of any disclosed O-ring as shown in Figs. 1 and 2.

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9. With respect to claims 8 and 9, Lukas discloses input ports 62, 68, 100 and 102 for supplying compressed gas to various chambers within the gun and opening/closing the bolt 32.

10. Claims 1, 2, 3, 4, 5, 6, 7, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5349938 issued to Farrell.

11. With respect to claim 1, Farrell discloses a piston 160; a bolt 150 connected to piston 160 and having a side port 166; and, a sealing member 126.

12. With respect to claim 2, Farrell discloses valve stem 130.

13. With respect to claim 3, Farrell discloses compressed gas chambers 34 and 170.

14. With respect to claim 4, Farrell discloses sealing member 126.

15. With respect to claim 5, Farrell discloses compressed gas chambers 34 and 170.

16. With respect to claim 6, Farrell discloses bolt port 166.

17. With respect to claim 7, the length of port 166 is greater than any dimension of sealing member 129.

18. With respect to claim 8, Farrell disclose input port 104.

19. With respect to claim 9, Farrell discloses compressed gas storage chambers 34 and 170.

20. Claims 1 and 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5769066 issued to Schneider.

21. With respect to claim 1, Schneider discloses a pneumatic assembly comprising piston 40; a bolt 20 including ports 26 and 21; and, a sealing member (o-rings at 23 and 27).

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22. With respect to claim 4, Schneider discloses sealing members (o-rings at 23 and 27).

23. With respect to claim 5, Schneider discloses compressed gas storage area 46.

24. With respect to claim 6, Schneider discloses Schneider discloses bolt ports 26 and 21.

25. With respect to claim 7, Schneider discloses bolt port 21 having a length greater than any dimension of sealing members at 23 and 27.

26. With respect to claim 8, Schneider discloses port 104 and compressed gas area 109.

27. With respect to claim 9, refer to Mode of Operation, col. 5, line 23 to col. 6, ll. 7.

The a) statements, b)"adapted to" or "adapted for" or "configured to/for" clauses, c) "wherein" clauses, or d) "whereby" clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

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Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

### ***Conclusion***

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited on form PTO-892 are cited as of interest to show similar pneumatic assemblies.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Chambers whose telephone number is (571) 272-6874 between the hours of 7:00 a.m. to 3:30 p.m., M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Carone, can be reached at (571) 272-6875.

Troy Chambers, Examiner

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